

2. The protector of claim 1 and further including a protective flap that extends between edges of the opening protecting the wearer from being pinched by the zipper.
3. (Amended) The protector of claim 1 wherein the length of the sleeve is selected to extend to approximately 1 to 1½ inches from an elbow of the wearer.
4. The protector of claim 1 wherein the sleeve includes decorative indicia on an uninterrupted surface.
5. The protector of claim 1 wherein the sleeve extends to a first joint of the thumb, leaving the joint exposed.
6. The protector of claim 1 wherein the sleeve extends to a point adjacent a first knuckle of the fingers and thumb, leaving the knuckles exposed.

REMARKS

In the Office Action, the Examiner rejected claims 1-6 as being obvious in light of the prior art. The application now includes claims 1-6.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over Elliot U.S. Patent No. 2,904,792 (hereinafter the "Elliot Patent") in view of the Bourdeau, et al. U.S. Patent No. 4,868,927 (hereinafter the "Bourdeau Patent"). The Examiner alleged that it would have been obvious of a person of ordinary skill in the glove making art at the time of the invention to replace the series of aligned apertures and a cord in the Elliot Patent with the zipper provided in the Bourdeau Patent to provide a more secure closing of the Elliot Patent glove on the wearer's arm.

Applicant respectfully disagrees with the Examiner that claim 1(Twice Amended) is obvious over the Elliot Patent in view of the Bourdeau Patent. An element of claim 1(Twice

Amended) is a single discrete digit opening disposed at another end of the sleeve wherein all of the wearer's fingers extend therethrough, wherein the sleeve extends to a point adjacent a first set of knuckles of the wearer's fingers leaving the knuckles exposed. This element further defines the sleeve as extending up to but leaving the knuckles of the digits of the hand exposed.

In contrast, the Elliot Patent discloses that "the sleeve is also flared outwardly towards an outer end wherein the enlarged portion 6 extends beyond the knuckles to the adjacent finger joints and is shaped to receive the wearer's hand." (Col. 2, Lines 4-8).

The Elliot Patent in view of the Bourdeau Patent does not teach each element of claim 1(Twice Amended). Therefore claim 1(Twice Amended) is not obvious over the Elliot Patent in view of the Bourdeau Patent. Reconsideration and allowance of claim 1(Twice Amended) is respectfully requested.

Since claim 1(Twice Amended) is in allowable form, claims 2-6 which depend from claim 1(Twice Amended) and are also in allowable form. Reconsideration and allowance of claims 2-6 are also respectfully requested.

The Examiner also rejected claims 1 and 3 as being obvious under 35 U.S.C. § 103(a) over Matthews U.S. Patent No. 5,402,536 (hereinafter the "Matthews Patent") in view of the Bourdeau Patent alleging that it would have been obvious to a person of ordinary skill in the art to include the zipper disclosed in the Bourdeau Patent on the side of the glove disclosed in the Matthews Patent. Furthermore, the Examiner alleges that FIG. 3 in the Matthews Patent shows the sleeve length arrangement of claim 3.

Applicant respectfully disagrees with the Examiner that claim 1(Twice Amended) is obvious over the Matthews Patent in view of the Bourdeau Patent. Claim 1(Twice Amended) includes as an element a single discrete opening disposed at another end of the sleeve wherein all of the wearer's fingers extend therethrough wherein the sleeve extends to a point adjacent to the first set of knuckles of the wearer's fingers, leaving the knuckles exposed.

In contrast, the Matthews Patent discloses individual finger openings. "The two halves are then placed with the moisture absorbing sides 3 and 7 opposing each other and attached

together by closure means at 22, 24, 26, 28, 30 and 32 in FIG. 2 leaving the finger openings 33, 34, 36, 38 or the pinkie, ring, middle and fore fingers respectively, a thumb opening and a forearm opening 42." (Col. 3, Lines 21-25). Therefore, the Matthews Patent discloses individual digit opening for the individual digits. Furthermore, referring to FIG. 3 of the Matthews Patent, the glove is shown to extend up to the first set of joints of the phalanges of the digits of the fingers.

In contrast, the hand and forearm protector defined in claim 1(Twice Amended) defines the protector extending up to the first set of knuckles of the wearer's finger leaving the knuckles exposed. The glove disclosed in the Matthews Patent shows the knuckles of the wearer's fingers being covered by the glove. Therefore, the Matthews Patent in view of the Bourdeau Patent does not disclose each and every element of claim 1(Twice Amended). As such, the Matthews Patent in view of the Bourdeau Patent, does not make claim 1(Twice Amended) obvious.

Claim 1(Twice Amended) is in allowable form. Reconsideration and allowance of claim 1(Twice Amended) is respectfully requested. Because claim 3 depends from claim 1(Twice Amended), claim 3 is also believed to be in allowable form. Reconsideration and allowance of claim 3 is respectfully requested.

#### Recapture Arguments

The Examiner rejected claims 1-6 under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. (*See Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 U.S.P.Q.2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 U.S.P.Q.2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1436, 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984). The Examiner alleges the cancellation of lines 11-15 and 17-19 in patent claim 1(Amended) constitutes a broadening aspect and these lines were added to the original patent claim 1 to define the prior art.

In the Office Action, the Examiner differed with Applicant's contentions regarding the recapture issue. In an Amendment dated May 3, 2001, Applicant stated that claiming the forearm protector as extending past the knuckles of the digits and up to the first set of phalanges of the digits leaving the phalanges exposed and also that the thumb opening of the forearm protector extending

up to the joint of the phalanges leaving the joint exposed was not supported by the specification and hence was not available to be surrendered.

The Examiner stated in the Office Action that the Examiner's position is that the subject matter was claimed and shown in the drawings in the original application and as such, was part of the original application. The Examiner contends that because the subject matter was alleged to be part of the original application, the subject matter was available to be surrendered. The Examiner also stated that the specificity of Applicant's arguments to these limitations on pages 2 and 5 of an Amendment dated July 23, 1998 and how their inclusion into the original claim 1 distinguishes it from the prior art, supports the Examiner's position.

Applicant respectfully disagrees with the Examiner's position that the subject matter was claimed and shown in the original application. Applicant's attorney has carefully reviewed the claims of the original application and found no support for the contention that the subject matter was claimed in the original application, thereby making it part of the original application. The subject matter which defined the digit opening extending up to the first set of phalanges of the joint and also the thumb opening extending to the first set of phalanges of the thumb was added in an Amendment on July 23, 1998. Therefore this subject matter was not part of the text of the original application.

Regarding the Examiner's contention that the drawings showed the sleeve extending up to and beyond the knuckles, Applicant's attorney additionally cannot find any support for this contention. The specification states, "The sleeve 12 of the hand and forearm protector extend up to each finger's first set of joints or knuckles 47, 49, 51 and 53. The first set of joints of the fingers 46, 48, 50 and 52 are defined as those joints or knuckles that are formed at the articulation of the metacarpal bone and the phalange of each finger." FIG. 1 of the application shows the location of the sleeve as extending up to but not covering the knuckles of the fingers which are called out as numbers 47, 49, 51 and 53. As can be seen from the drawings, the reference lines extend past the edge of the sleeve and therefore, the drawings do not show the sleeve extending beyond the knuckles of the fingers. Additionally, the knuckles are illustrated in solid lines which show the knuckles as

being exposed. If the knuckles were covered by the sleeve, the knuckles would have been illustrated in dashed lines.

Furthermore, the knuckles 47, 49, 51 and 53 are defined as the articulation of the metacarpal bone with the phalange. The metacarpal bone is the bone that extends from the wrist up to the start of the fingers. The phalanges are the bones which provide skeletal structure to the fingers. Therefore, the specification further defines that the sleeve does not extend beyond the knuckles of the fingers.

Regarding the Examiner's reliance on the arguments in the remarks of the Amendment filed on July 23, 1998, once Applicant's attorney inadvertently and without any deceptive intent, claimed the subject matter which was not supported by the specification, this subject matter was used to distinguish over the prior art. Whether or not the subject matter was used to distinguish over the prior art is not of consequence in this reissue application. What is of consequence, is subject matter was inadvertently claimed which was not supported by the specification. Consequently, claim 1 claimed subject matter which was not supported by the specification and as such, claimed more than Applicant was entitled to claim, thereby creating a 35 U.S.C. § 112, ¶ 1 issue.

The subject matter defining the forearm protector extending past the knuckles and up to the first set of phalanges does not exist in the specification and therefore was not available to be surrendered. As such, this reissue is not an issue of recapture, but rather an issue of having claimed more than what was allowed because more was claimed than was supported by the specification.

Similarly, claim 1 defined a thumb opening extending beyond the joint of the metacarpal and phalange and extending up to the joint of the phalanges but leaving that joint exposed. Again, the specification does not support such a claim. "Similarly, the thumb opening 18 has an edge 55 that is disposed to extend the sleeve to a position such that the first joint or knuckle of the thumb that is formed between the metacarpal bone and the phalange is exposed." (Col. 3, Lines 21-25). Again, the subject matter that was claimed which defines the thumb opening of the hand and forearm protector extending up to the joint of the phalanges is not supported by the

specification. Again, this is not an issue of recapture but rather an issue of claiming more than what was supported by the specification creating a 35 U.S.C. § 112, ¶ 1.

The original application did not disclose the hand and forearm protector extending up to the first set of joints of the phalanges of the fingers and thumb. Rather, the original application disclosed the sleeve and forearm protector extending up to but leaving exposed, the knuckles of the fingers and also the joint of the metacarpal and phalange joint of the thumb. Therefore, this is not an issue of recapture, but rather an issue of claiming more than what was supported by the specification. As such, Applicant respectfully requests that the rejection based on the recapture of subject matter under 35 U.S.C. § 251 be withdrawn.

#### Drawings

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a). The Examiner stated the drawings must show each and every feature of the invention specified in the claims. The Examiner stated that the decorative indicia recited in claim 4 must be shown or the feature is canceled from the claims. The Examiner stated that the markings observed looked like wrinkles.

Again, Applicant respectfully disagrees with the Examiner that decorative indicia is not present in the drawings. Indicia is defined as a distinctive mark that indicates. *Merriam-Webster's Third International Dictionary of the English Language Unabridged*, Merriam-Webster Pub. Co., p. 1150 (1986). FIGS. 1, 2, 5 and 6 show markings on the sleeve. While the Examiner considers these markings to look like wrinkles, they are indicia based upon the definition. As such, claim 4 is supported by the drawings. Applicant respectfully requests that the objection to claim 4 be withdrawn.

#### Conclusion

For the foregoing reasons, claim 1(Twice Amended) and claims 2-6 are in allowable form. Reconsideration and allowance of claims 1(Twice Amended) and claims 2-6 is respectfully requested.

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Application No.: 09/519,889

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The Commissioner is authorized to charge any additional fees associated with this paper or credit any overpayment to Deposit Account No. 11-0982. A duplicate copy of this communication is enclosed.

Respectfully submitted,

KINNEY & LANGE, P.A.

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**APPENDIX:  
MARKED UP VERSION OF SPECIFICATION AND CLAIM AMENDMENTS**

1.(Twice Amended) A hand and forearm protector comprising:

- a sleeve for overlying a forearm and a proximal hand portion of a wearer;
- a primary opening at one end of the sleeve;
- a single discrete digit opening disposed at another end of the sleeve wherein all of the wearer's fingers extend therethrough, wherein the sleeve extends to a point adjacent a first set of [joints] knuckles of the wearer's fingers, leaving the [joints] knuckles exposed;
- a discrete thumb opening disposed at another end of the sleeve;
- a longitudinal opening along the sleeve extending adjacent from a point that overlies a juncture of the carpal bones and the radius and extending rearwardly towards the primary opening to proximately the end of the sleeve; and
- a zipper for closing the longitudinal opening to conform the sleeve to the forearm of the wearer, the closure being disposed to overlie a forward side of the forearm.